

REMARKS

This Amendment is submitted in response to the 23 September 2003 OFFICE ACTION. This Amendment does not narrow the claims. Therefore, the doctrine of equivalents accorded the claims remains unaffected by *Festo*.

5 Claims 1-66 are pending. All claims stand rejected as obvious over MOSSBERG combined with HARTMANN, further combined with either BORGURAYEV or PEACH. Because the obviousness rejections have several irreparable flaws, they must each be withdrawn as a matter of law.

We first discuss each reference, and then discuss the combination of references.

10 MOSSBERG

Walter S. MOSSBERG, *Threats to Privacy On-Line Become More Worrisome*, The Wall Street Journal page B1 (24 Oct. 1996) discusses threats to privacy on-line. MOSSBERG says:

15 There are some situations developing on the Web in which information about you
might be made available without your permission or voluntary action. There are
at least three forms of this involuntary publication of which I'm aware. One,
called "mining," involves using automated software to scoop up your e-mail
address from public discussion groups in which you have participated and then
publishing it on directory sites where anybody can retrieve it. A second practice
involves companies trying to capture your "click stream," which is the history of
20 what you choose to view on the Web, to ascertain your likes and dislikes and
create a profile that can be sold to marketers.

The third technique involves publishing on the Web various government and other databases, such as Social Security or auto-registration data.

25 Id. at ¶¶ 8-9. MOSSBERG cannot make the claims obvious, because MOSSBERG fails to enable the claimed limitation, and because Applicant has already antedated MOSSBERG.

MOSSBERG does not enable the claimed limitation

30 The OFFICE ACTION asserts that MOSSBERG teaches the claim limitations, “Searching the Internet, Identifying web pages and Internet postings containing profile data.” OFFICE ACTION at 9 (24 Sept. 2002).

A reference cannot render obvious a claim if the reference does not enable the claimed limitation. *E.g.*, Ashland Oil Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 U.S.P.Q. 657 (Fed.Cir. 1985), *cert. denied*, 475 U.S. 1017. Here, MOSSBERG says nothing regarding *how* a user can identify web postings “containing profile data.” MOSSBERG
5 therefore fails to enable the claimed limitation.¹ Because MOSSBERG does not enable the claimed limitation, MOSSBERG cannot be relied on.

Applicant antedates Mossberg

Applicant has already antedated MOSSBERG.

This application is a continuation-in-part of Serial No. 08/984,650, now U.S. Patent
10 6,381,592. The two claim limitations allegedly taught by MOSSBERG (“searching the Internet” and “identifying an Internet page or web posting”) were both recited in the claims of the parent.

During prosecution of the parent, the Office acknowledged that the Applicant possessed both of these claim limitations not later than 10 Sept. 1996. *See* RULE 1.131 DECLARATION (14 July 2000). This is six weeks before the 24 October 1996 effective date for MOSSBERG.

15 So what? Everyone knows that antedating possession of only two claim limitations does not antedate a reference against the entire (five-limitation) claim. Rather, an applicant must show antedating possession of the claim as a whole.

Here, however, such possession of the claim as a whole is alleged by the OFFICE ACTION itself. This is because possession of a claim element carries with it possession of obvious
20 variations and combinations of it. In re Spiller, 500 F.2d 1170, 182 U.S.P.Q. 614 (C.C.P.A. 1974); In re Stryker, 435 F.2d 1340, 168 U.S.P.Q. 372 (C.C.P.A.1971). In the immediate case, the OFFICE ACTION itself alleges that the other claim limitations are mere obvious variations or combinations on “searching” and “identifying.” OFFICE ACTION at ¶ 32 (24 Sept. 2002) (“it would have been obvious to one of ordinary skill in the art to have included...”), ¶ 37 (same), ¶
25 12 (same). In arguing that all claim limitations are obvious variations on MOSSBERG, the

¹ If the Examiner believes MOSSBERG enables the limitations, the Examiner is invited to provide an AFFIDAVIT OF REFERENCES introducing into the record documentary evidence proving that MOSSBERG would have enabled practicing the limitation at the time the claimed invention was made.

OFFICE ACTION says that all claim limitations merit the pre-MOSSBERG date already established in this case.

An Applicant “may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any
5 of the references; applicant need not antedate the reference with the earliest filing date.”
MANUAL PAT. EXAM. PROC. § 715.02 (Aug. 2001). Here, the Office has already acknowledged that Applicant possessed two claim elements before the MOSSBERG effective date. If the other claim limitations are mere obvious variations of these two claim limitations (per the OFFICE ACTION), then the claims as antedate MOSSBERG, and all rejections based in whole or part on
10 MOSSBERG must be withdrawn.

HARTMAN

Hartman

Richard L. HARTMAN *et al.*, United States Letters Patent No. 5,758,324, teaches a resume database. Data is input into the HARTMAN database using resumes and a variety of
15 template forms, as shown in HARTMAN at Figs. 3, 4.

Hartman does not teach the claim limitations

Claim 1 describes a method with several steps:

- a. Searching the Internet,
- b. Identifying web pages and Internet postings containing professional profile data,
- 20 c. Collecting said professional profile data,
- d. Identifying in said professional profile text strings constituting contact information, and
- e. Storing said ... data into a data structure.

HARTMAN teaches a resume database. The OFFICE ACTION correctly notes that HARTMAN
25 teaches “Storing [] data into a data structure,” and fails to teach steps “a.” and “b.” Step c. in turn recites, “Collecting *said* professional profile data,” not “Collecting unrelated professional profile data from some unrelated source.” Because HARTMAN fails to teach step b., HARTMAN cannot by definition teach step c.

Hartman has already been reviewed

HARTMAN was of record during prosecution of the parent application. NOTICE OF REFERENCES CITED (14 Dec. 1999). In reviewing HARTMAN, the Office found it did not render the parent claims obvious. The Office thus allowed the parent application to issue.

5 The OFFICE ACTION contradicts the Office's earlier factual conclusions regarding HARTMAN. The Office is respectfully believed estopped from reversing its previous factual holding, unless the Office shows how the two situations differ. Specifically, the Office must show: (1) how the pending claims and the already-allowed claims are patentably distinct; (2) how HARTMAN failed to teach this limitation in the allowed claims, and (3) how HARTMAN
10 teaches this limitation in the pending claims.²

BOGURAYEV

Bogurayev

15 Branimir K. BOGURAEV, U.S. Letters Patent No. 5,799,268, teaches an automated method for compiling a software technical assistance database. Specifically, the reference teaches a "method involving computer-mediated linguistic analysis of online technical documentation to extract and catalog from the documentation knowledge essential to, for example, creating a online help database." *Id.* at Abstract. BOGURAEV explains:

20 The present invention describes a method involving computer-manipulated linguistic analysis of online technical documentation for automatically generating a catalog of pertinent information defining, in a concise formal structure, the domain, i.e., the topic or application about which the online documentation provides detailed background information.

25 *Id.* at col. 6, line 64 to col. 7, line 5. While the method works with software technical documentation, BOGURAEV cautions that this approach does not work with other kinds of documentation:

Technical documents represent a well defined genre of text, sharing common features of style, form, content and presentation. As will be seen, acknowledging

² Properly establishing point (1) will require withdrawing the current obviousness rejections.

5 and accounting for such expository features found in such documentation allows for certain types of linguistic analysis to be applied in a particular way to map the text of a document onto a concise, formal structure of linguistic objects representative of the key terms and their properties, as well as the relations (i.e., actions) between them, found in the domain to which the documentation is directed.

Id. at col. 9, lines 1-10. BOGURAYEV does not support an obviousness rejection for the following reasons.

10 Bogurayev is from a non-analogous art

An obviousness combination cannot rely on a reference from a non-analogous art. For example, single inline memory modules (SIMM) of varying sizes for industrial computers, is not analogous art *vis* claims for SIMMs of modular size for personal computers. Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 U.S.P.Q. 1767 (Fed. Cir. 1993).

15 Here, BOGURAYEV is non-analogous art. BOGURAYEV addresses online software technical documentation, not user-entered professional profile resume information as in HARTMAN. BOGUURAYEV addresses online software documentation only, saying that it works only with software documentation, because software documentation is a “well defined genre of text, sharing common features of style, form, content and presentation.” *Id.* at col. 9,
20 lines 1-3. In contrast, the claimed invention works with catholic online text, having widely varied “features of style, form, content and presentation.”

Because BOGURAYEV itself says it is in a non-analogous art, an art used to process non-analogous data, BOGURAYEV cannot be used for an obviousness rejection.

THE PRIMA FACIE CASE

25 A *prima facie* case of obviousness requires that the art of record teach both: (1) a suggestion or motivation to combine the references; and (2) a reasonable expectation of success in making the combination. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Here, the art of record has neither.

The art of record lacks any suggestion to make the combination.

A *prima facie* case of obviousness requires some suggestion to make the combination. This suggestion or motivation must be recited in the references. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

5 Here, the OFFICE ACTION asserts that the claimed combination has “the advantage of providing a method of collecting professional profile data with internet data harvesting capabilities.” OFFICE ACTION at ¶¶ 12, 37 (24 Sept. 2002). This motivation, however, is not recited in any reference of record. Because the OFFICE ACTION does not identify where this motivation appears *in the references of record*, the OFFICE ACTION has not pled a *prima facie*
10 case of obviousness.

The art teaches an expectation of failure

A *prima facie* case of obviousness requires the art of record teach a reasonable expectation of success in making the combination. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Here, the art of record teaches a reasonable expectation of failure.

15 Hartman teaches away from the combination

HARTMAN teaches away from the combination of references. HARTMAN teaches a system which requires the user to input data in a fillable form:

20 During the session, the server 12 communicates to the applicant’s client machine a resume outline form 30 (FIG. 3) to be completed by a job applicant. The form 30 has a plurality of fields 31 relevant to employment, using which typical information found on a resume is summarized by the applicant. The form 30 has fields that are similar to blanks found on traditional job application forms available from employers.

25 HARTMAN at col. 5, lines 25-34. Upon receiving this form, the job applicant fills in as many fields as desired. Id. at col. 6, lines 8-14. In HARTMAN, the applicant’s name and contact information is not “mined” from the internet; to the contrary, HARTMAN specifies that manually inputting this data into the database is “mandatory.” Id.

30 Furthermore, HARTMAN admonishes that it should not be combined with BOGURAYEV nor MOSSBERG. HARTMAN says that automated data mining per MOSSBERG and BOGURAYEV does not work:

5 Still other attempts have employed the aforementioned OCR conversion to allow the use of “keyword” search methods on the resulting text full of resumes, in an attempt to find those which contain key words or phrases. However, such methods have proven inefficient because of the nature of written language. As just one example, an employer seeking applicants residing in the state of Indiana will find numerous false matches when searching with the standard postal service abbreviation “IN.” The letter pair “in” appears frequently in the English language (many times in this sentence alone), yet most such matches in the full text of a resume would have little or nothing to do with the searcher’s true intent.

10 A further difficulty with “keyword” search methods is the requirement that the words or phrases in question must match with near-perfect accuracy. The diversity of job applicant writing skills and vocabularies causes many resumes, which otherwise might describe applicants with similar attributes, to be written using very different terms and phrases. Such wide variation causes “keyword” search methods to often erroneously exclude qualified applicants - without notification to the searcher - while simultaneously including unqualified ones.

20 HARTMAN at col. 1, line 59 to col. 2, line 14. HARTMAN thus teaches his system precludes using automated search methods. Rather, HARTMAN says that this data must be input by the users, rather than “mined” from online documents. *E.g.*, *id.* at col. 5, lines 25-33; col. 6 lines 26-47; col. 6, lines 8-14, 59-67. HARTMAN says that automated data mining technology will not work at all, or will work badly and generate “outdated information and questionable results”:

25 The preferred embodiment section of the patent then describes a system designed for use by such agencies and firms - without direct applicant involvement of any kind.

30 Other attempts have allowed applicants to initially enter some data, but make no explicit provision for ongoing involvement. Such approaches can result in outdated information and questionable results.

HARTMAN at col. 2, line 26-34. HARTMAN goes to great lengths to specify that the system requires not catholic web content, but *resumes*. *E.g.*, *id.* at col. 6, lines 8-14, lines 26-47.

35 HARTMAN teaches away from using MOSSBERG or BOGURAYEV, or any other keyword search technology. Because it is improper to combine references where the references teach away from their combination, In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983), HARTMAN cannot be combined with MOSSBERG nor with BOGURAYEV.

Bogurayev teaches away from the
combination

Similarly, BOGURAYEV teaches a reasonable expectation of failure. BOGURAYEV teaches an approach that works only when the online content is a “well defined genre of text, sharing common features of style, form, content and presentation.” *Id.* at col. 9, lines 1-3. In so doing, BOGURAYEV teaches away from using his system with a diverse set of online documents which do not make any “well defined genre of text, sharing common features of style, form, content and presentation.” BOGURAYEV thus teaches a reasonable expectation of failure, not success, when used with catholic, diverse online content. Because BOGURAYEV teaches a reasonable expectation of failure (not success), it cannot support an obviousness rejection. If the Examiner disagrees, please provide an AFFIDAVIT OF REFERENCES introducing into the record documentary evidence proving that the BOGURAYEV system works with the broad range of online content discussed in the application.

Secondary indicia of non-obviousness

Synergistic effectiveness indicates non-obviousness. Here, the OFFICE ACTION asserts that the claimed combination has “the advantage of providing a method of collecting professional profile data with internet data harvesting capabilities.” OFFICE ACTION at ¶¶ 12, 37 (24 Sept. 2002). The OFFICE ACTION argues that the claimed combination has is a synergistic advantage *vis* the art of record. Such synergistic effectiveness indicates the claimed combination is *non-obvious*.

Similarly, the OFFICE ACTION asserts that an advertising message “does not functionally relate to the steps in the method claimed.” OFFICE ACTION at ¶ 32 (24 Sept. 2002). This factual assertion supports the *non-obviousness* of the contested claim.

SUMMARY


Because the OFFICE ACTION does not plead a *prima facie* case of obviousness, the rejections must be withdrawn.

Applicant notes that the patents cited in the OFFICE ACTION do not recite paragraph numbers. Accordingly, to avoid confusion in resolving any Appeal, the Examiner is respectfully

requested to cite to patents by column and line number, rather than by paragraph number, in any future Office Action or Reply Brief.

Respectfully submitted,

5



Mark POHL, Reg. No. 35,325
11 February 2003

10

PHARMACEUTICAL PATENT ATTORNEYS LLC
55 Madison Avenue, 4th floor
Attention : Mark POHL (P 4014)
Morristown, NJ 07960-7397 USA

15

Direct: *Mark.Pohl@LicensingLaw.Net*

☎ +1 (973) ~~665-0275~~

584 0076

Enclosures:

20

In re Stryker, 435 F.2d 1340 (C.C.P.A.1971).

In re Spiller, 500 F.2d 1170 (C.C.P.A. 1974);

In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983),

Ashland Oil Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281 (Fed.Cir. 1985)

In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

25

Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993).